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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,206	12/12/2003	James Kelly	C1120	1794
26308	7590	05/23/2006	EXAMINER	
RYAN KROMHOLZ & MANION, S.C. POST OFFICE BOX 26618 MILWAUKEE, WI 53226			QIN, JIANCHUN	
			ART UNIT	PAPER NUMBER
			2837	
DATE MAILED: 05/23/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No. 10/735,206	Applicant(s) KELLY, JAMES	
	Examiner Jianchun Qin	Art Unit 2837	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-10, 19, 20, 31-34, 48 and 49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 31-34 is/are allowed.
- 6) ☒ Claim(s) 8-10, 19, 20, 48 and 49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

*Response to Amendment*

1. Upon further consideration, the allowable subject matter of claims 8-10, 19, 20, 48 and 49 as indicated in the last Office Action mailed on 12/28/2005 have been withdrawn and replaced by the following office action. Any inconvenience to the Applicant(s) is regretted.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders (U.S. Pat. No. 3728929) in view of Runyon (U.S. Pat. No. 6673992) and Ostermeyer (U.S. Pat. No. 5479842).

With respect to claim 8:

Sanders teaches a mouthpiece for a brass wind musical instrument (col. 1, lines 56-65; col. 2, lines 10-18 and lines 25-29).

Sanders does not mention: said mouthpiece is colored; the mouthpiece being made solely from a selected polymer material; a colorant of a selected color that imparts the selected color to the polymer material; and a mouthpiece removably insertable into the wind musical instrument and made solely from a polycarbonate material and a selected colorant material, so that the mouthpiece exhibits the color of the selected colorant material and wherein the first color is brass, gold, or silver color, and wherein the polycarbonate material and the selected colorant material cooperate to render the mouthpiece a color that is neither brass, gold, nor silver color, so that the mouthpiece color contrasts with the first color

Runyon teaches a mouthpiece for wind musical instrument, and said mouthpiece being made solely from a selected polymer material (col. 6, lines 59-62).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teaching of Runyon in the invention of Sanders in order to provide a mouthpiece for various wind musical instruments which is lightweight, less expensive, more user-friendly, and better for harmonic vibration (Runyon, col. 6, lines 59-62).

Ostermeyer teaches a wind musical instrument having a first color (col. 2, lines 39-46); and a mouthpiece removably insertable into the wind musical instrument and made solely from a polycarbonate material and a selected colorant material, so that the mouthpiece exhibits the color of the selected colorant material, and wherein the polycarbonate material and the selected colorant material cooperate to render the

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mouthpiece a color that is different from the first color, so that the mouthpiece color contrasts with the first color (Ostermeyer, col. 3, lines 16-29).

It would have been obvious to one having ordinary skill in the art to modify the combination of Sanders and Runyon as taught by Ostermeyer to color the polymer mouthpiece by include a desired color that imparts the selected color to the polymer material for the purpose of making the musical instrument more attractive to the users (cols. 1-2, lines 65-3).

With respect to claims 9 and 10:

The teaching of Ostermeyer further includes: wherein the mouthpiece is opaque (col. 3, lines 16-29); wherein the mouthpiece is transparent (col. 3, lines 16-29).

It would have been obvious to one having ordinary skill in the art to modify the combination of Sanders and Runyon as taught by Ostermeyer to color the polymer mouthpiece by include a desired color that imparts the selected color to the polymer material for the purpose of making the musical instrument more attractive to the users (cols. 1-2, lines 65-3).

4. Claims 19, 20, 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders in view of Runyon, Ostermeyer and Dolmetsch (U.S. Pat. No. 3,750,521).

With respect to claim 19:

It is obvious that Sanders in view of Runyon and Ostermeyer obviously disclose the method steps of manufacturing a mouthpiece as claimed except: the mouthpiece is manufactured by an injection molding process.

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Dolmetsch teaches a mouthpiece (21) made by injection molding (col. 2, lines 19-20) for mass production.

It would have been obvious to one having ordinary skill in the art to modify Sanders in view of Runyon and Ostermeyer's mouthpiece as taught by Dolmetsch to include the mouthpiece being manufactured by an injection molding process for the purpose of mass production.

With respect to claim 20:

Sanders in view of Runyon teach the claimed invention except inserting the mouthpiece into the musical instrument and thereby presenting contracting colors between the musical instrument and the mouthpiece.

Ostermeyer teaches a mouthpiece that can have any desired color (col. 3, lines 16-29).

It would have been obvious to one having ordinary skill in the art to modify the combination of Sanders and Runyon as taught by Ostermeyer to color the polymer mouthpiece by include a desired color that imparts the selected color to the polymer material for the purpose of making the musical instrument more attractive to the users (Ostermeyer, cols. 1-2, lines 65-3).

With respect to claims 48 and 49:

Sanders discloses the steps of a. and b. (a design that replicates the traditional cup, throat, back bore and performance of brass mouthpiece... ), and Sanders in view of Runyon, Ostermeyer and Dolmetsch obviously disclose the other method steps as claimed.

***Allowable Subject Matter***

5. Claims 31-34 are allowed.

***Reasons for Allowance***

6. The claims are allowable over the prior art for at least the reason that the prior art fails to reasonably teach or suggest in claim 31 that a mouthpiece bounded by a first outer periphery and a first aperture, the mouthpiece being fabricated by molding a mixture of polymer material and selected colorant material into a blank having a second outer periphery and a second aperture, and by performing a primary machining operation on the blank second outer periphery and second aperture to produce the first outer periphery and the first aperture as set forth in the claimed combination.

In regard to dependent claims 32-34, they are allowed once the independent claim they depend on is allowed, even though they may contain allowable subject matter themselves.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Response to Arguments***

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7. Applicant's arguments received 04/20/06 with respect to claims 8-10, 19, 20, 31-34, 48 and 49 have been considered but are moot in view of the new ground(s) of rejection.

Claims 8-10, 19, 20, 48 and 49 are rejected as new prior art reference (U.S. Pat. No. 5479842 to Ostermeyer) has been found to teach, together with other cited references, the claimed invention recited in the claims listed above. Detailed responses are given in sections 2 and 3 as set forth above in this Office Action.

***Contact Information***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jianchun Qin whose telephone number is (571) 272-5981. The examiner can normally be reached on 8am - 5:30pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lincoln Donovan can be reached on (571) 272-1988. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jianchun Qin  
Examiner  
Art Unit 2837

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